



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,646	07/27/2000	David H. Tannenbaum	T0615-P005US-08008819	9955

29053 7590 10/10/2003

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
2200 ROSS AVENUE  
SUITE 2800  
DALLAS, TX 75201-2784

EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 10/10/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/625,646

Applicant(s)

TANNENBAUM, DAVID H.

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-80 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-26, 44-51, 61-70 and 75-78, drawn to a system and a method for delivering information to a requesting user, comprising the means and steps of:  
a) recording a requesting from a user pertaining to information content desired by the user; b) accessing the recorded request by any information provider; c) determining by the accessing information provider whether or not the information said accessing provider has control of matches the information content requesting by the user, classified in class 707, subclass 1.
- II. Claims 27-37 and 79-80, drawn to a method for allowing a TV user to receive programs desired by that user, comprising the steps of: a) accepting from the user information pertaining to a program desired to be viewed by the user; b) matching the accepting information against a list of known programs currently scheduled to be delivered; c) informing the user as to when the program will be delivered; and d) allowing the viewer to receive the programs at the informed time, classified in class 725, subclass 39.
- III. Claims 38-43, drawn to a system for delivering entertainment programs to a user, the system comprising: a) means for allowing the user to input and stored desired programs; b) means operative from time to time for accessing stored ones of said desired programs; c) means for determining which, if any, of said stored desired programs are currently available to said user; and d) means controlled in part by said accessing means for delivering to said user one or more of said stored desired program which were determined not to have been currently available to the user, after said programs are determined to be available, classified in class 725, subclass 47
- IV. Claims 52-60, drawn to a method of delivering information from any of a plurality of information sources to an information seeker wherein each said information seeker

Art Unit: 2153

has caused to be remembered abstracts of information being sought by said information seeker, the method comprising the steps of: a) searching... whether information available to at least one of said sources matches the abstracts of sought information; and b) notifying the information seeker that at least one match has been found, classified in class 725, subclass 53.

V. Claims 71-74, drawn to a method of providing to a user information pertaining to geographically diverse locations, the method comprising the steps of: a) providing under control of any user an identity of an enterprise, the enterprise having a plurality of geographically diverse locations; b) storing provided one of the enterprise identities; and c) accessing the stored provided ones of the identities by the enterprise so as to be able to provide each said user with information specific to an enterprise location at a current location of said user, classified in class 725, subclass 35.

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) accepting from the user information pertaining to a program desired to be viewed by the user; b) matching the accepting information against a list of known programs currently scheduled to be delivered; c) informing the user as to when the program will be delivered; and d) allowing the viewer to receive the programs at the informed time.

3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system and a method for delivering information to a requesting user lacks ) means for allowing the user to input and stored desired programs; b) means operative from time to time for accessing stored ones of said desired programs; c) means for determining which, if any, of said stored desired

Art Unit: 2153

programs are currently available to said user; and d) means controlled in part by said accessing means for delivering to said user one or more of said stored desired program which were determined not to have been currently available to the user, after said programs are determined to be available.

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) searching... whether information available to at least one of said sources matches the abstracts of sought information; and b) notifying the information seeker that at least one match has been found.
5. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) providing under control of any user an identity of an enterprise, the enterprise having a plurality of geographically diverse locations; b) storing provided one of the enterprise identities; and c) accessing the stored provided ones of the identities by the enterprise so as to be able to provide each said user with information specific to an enterprise location at a current location of said user.
6. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a system and a method for delivering information to a requesting user lacks ) means for allowing the user to input and stored desired programs; b) means operative from time to time for accessing stored ones of said desired programs; c) means for

determining which, if any, of said stored desired programs are currently available to said user; and d) means controlled in part by said accessing means for delivering to said user one or more of said stored desired program which were determined not to have been currently available to the user, after said programs are determined to be available.

7. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) searching... whether information available to at least one of said sources matches the abstracts of sought information; and b) notifying the information seeker that at least one match has been found.

8. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) providing under control of any user an identity of an enterprise, the enterprise having a plurality of geographically diverse locations; b) storing provided one of the enterprise identities; and c) accessing the stored provided ones of the identities by the enterprise so as to be able to provide each said user with information specific to an enterprise location at a current location of said user.

9. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) searching... whether information available to at least one of said sources matches the abstracts of sought information; and b) notifying the information seeker that at least one match has been found.

10. Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) providing under control of any user an identity of an enterprise, the enterprise having a plurality of geographically diverse locations; b) storing provided one of the enterprise identities; and c) accessing the stored provided ones of the identities by the enterprise so as to be able to provide each said user with information specific to an enterprise location at a current location of said user.

11. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as a system and a method for delivering information to a requesting user lacks the steps of: a) providing under control of any user an identity of an enterprise, the enterprise having a plurality of geographically diverse locations; b) storing provided one of the enterprise identities; and c) accessing the stored provided ones of the identities by the enterprise so as to be able to provide each said user with information specific to an enterprise location at a current location of said user.

12. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

13. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-26, 44-51, 61-70 and 75-78) would require use of search class 707, subclass 1 ( which would not required for the groups II, III, IV and V).

Art Unit: 2153

(b) the Group II search (claims 27-37 and 79-80) would require use of search class 725, subclass 39 (which would not required for the groups I, III, IV and V).

c) the Group III search (claims 38-43) would require use of search class 725, subclass 47 ( which would not required for the groups I, II, IV and V).

(d) the Group IV search (claims 52-60) would require use of search class 725, subclass 53 (which would not required for the groups I, II, III and V).

(e) the Group V search (claims 71-74) would require use of search class 725, subclass 25 (which would not required for the groups I, II, III and IV).

14. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed.

15. Applicant is reminded that the required for response to this requirement is 30 days, not one month.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone



Art Unit: 2153

numbers for the organization where this application or proceeding is assigned is are as following:

(703) 746-4481 [Direct Fax Number]

(703) 746-7238 [After Final Communication]

or

(703) 746-7239 [Official Communication]

(703) 746-7240 [For Status inquiries, draft communication]

and/or

(703) 306-5631, (703) 306-5632 or (703) 306-5633 for [Customer Service Numbers]

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

KI

October 7, 2003



KRISNA LIM  
PRIMARY EXAMINER